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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,112	08/10/2001	Rachel Meyers	381552004800	3858

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EXAMINER

PAK, YONG D

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 10/22/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,112

Applicant(s)

MEYERS ET AL.

Examiner

Yong Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-23 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 and 6, drawn to DNA encoding a phospholipase, host cell comprising thereof and a method of producing polypeptide, classified in class 435, subclass 197.
- II. Claims 4, drawn to a phospholipase, classified in class 435, subclass 197.
- III. Claim 5, drawn to antibody against the phospholipase, classified in class 530, subclass 387.9.
- IV. Claims 7-8 and 11-12, drawn to a method of detecting the presence of the polynucleotide and a kit, classified in class 435, subclass 6.
- V. Claim 9-10, drawn to a method for identifying a compound which binds to the polypeptide, classified in class 514, subclass 789.
- VI. Claims 11-12, drawn to a method for identifying a nucleic acid molecule associated with a disorder, classified in class 435, subclass 6.
- VII. Claim 13, drawn to a method for identifying a polypeptide associated with a disorder, classified in class 435, subclass 15.
- VIII. Claims 14-15, drawn to a method for identifying a subject having a disorder by contacting a sample comprising DNA, classified in class 435, subclass 6.

- IX. Claims 16, drawn to a method for identifying a subject having a disorder by contacting a sample comprising a polypeptide, classified in class 435, subclass 15.
- X. Claims 17, drawn to a method for identifying a compound for treatment, classified in class 514, subclass 789.
- XI. Claims 18-19, drawn to a method of treatment comprising a peptide, classified in class 514, subclass 2.
- XII. Claims 18-19, drawn to a method of treatment comprising an antibody, classified in class 424, subclass 130.1.
- XIII. Claims 18-19, drawn to a method of treatment comprising the polypeptide of SEQ ID NO:2, classified in class 424, subclass 94.5.
- XIV. Claims 18 and 20, drawn to a method of treatment comprising an antisense, classified in class 514, subclass 44.
- XV. Claims 18 and 20, drawn to a method of treatment comprising an ribozyme, classified in class 514, subclass 44.
- XVI. Claims 18 and 20, drawn to a method of treatment comprising the nucleic molecule of SEQ ID NO:1 or 3, classified in class 514, subclass 44.
- XVII. Claims 21, drawn to a method for evaluating the efficacy of a treatment of a disorder, classified in class 435, subclass 4.
- XVIII. Claims 22-23, drawn to a method of diagnosing a disorder in a subject, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are patentably distinct because a DNA, a protein, and an antibody are different compounds, each with its own chemical structure and function, and they have different utilities. DNA of Inventions I are patentably distinct as encoding enzymes with different structures, functions, substrate specificities, and utilities. The proteins of Inventions II are patentably distinct as having different structures, functions, substrate specificities, and utilities.

The DNA molecule of invention I is not limited in use to the production of polypeptide of invention II, respectively, and can be used as a hybridization probe, and protein of Invention II can be obtained by a materially different method such as by biochemical purification. The structure of an antibody of Invention III is not predictable from the structure of the protein of Invention II and an antibody can cross-react with various proteins.

Inventions I and (IV, VI, VIII, X and XVI-XVIII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA of Inventions I can be used for the production of the protein of Invention II or in hybridization assays.

Inventions II and (V, VII, IX, X, XIII and XVII-XVIII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be

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practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein of Invention II can be used for the production of the antibody of Invention III.

The methods of Inventions IV-XVIII are patentably distinct as directed to materially different methods employing different products. Invention IV, VI VIII and XVI use DNA. Inventions V, VII, IX and XIII use polypeptides. Invention X and XVII-XVIII use DNA or polypeptides encoded by the DNA. Invention XI uses a peptide, Invention XII uses an antibody, Invention XIV uses an antisense and Invention XV uses a ribozyme.

Inventions IV, VI VIII and XVI are patentably distinct because the methods have different effects and utilizes. Invention V, VII, IX and XIII are patentably distinct because the methods have different effects and utilizes. Invention X and XVII-XVIII are patentably distinct because the methods have different effects and utilizes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak
Patent Examiner

October 18, 2002



PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNICAL CENTER 1652